

Application No.: 10/758,006  
Reply to April 5, 2007 Office Action

Docket No.: 1248-0683P  
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**AMENDMENTS TO THE DRAWINGS**

Please find attached a replacement sheet of drawings that includes changes to Figure 8.

### REMARKS

Claims 1-9 are pending in this application. In the current response, claims 1-2 and 8 are amended while claims 4-7 are canceled. Claims 1-3 and 8-9 are pending. Claims 1 and 8 are independent claims.

The Office Action mailed April 05, 2007 is summarized as follows:

The drawings have been objected to on the grounds that Figure 8 is not labeled as "prior art."

Claim 8-9 is objected to as being dependent upon a rejected base claim, but is indicated as allowable if rewritten in independent form.

Claims 1, 3, and 5-6 stand rejected under §103(a) as being unpatentable over Applicant's disclosure in view of Cai, U.S. Patent 5,029,182 (hereinafter, "Cai").

Claims 2, 4, and 7 stand rejected under §103(a) as being unpatentable over Applicant's disclosure in view of Cai, and further in view of Sugano, JP 2001068953A (hereinafter, "Sugano").

Claim 1 is additionally rejected as being unpatentable over Applicant's disclosure in view of Roberts et al, U.S. Patent 5,142,695 (hereinafter, "Roberts"), and further in view of Motojima, JP 60019311A (hereinafter, "Motojima").

Applicants respectfully traverse these rejections, however in order to advance prosecution, claims 1-2 and 8, as discussed below, have been amended to more clearly distinguish the present invention from the prior art.

### **OBJECTION TO THE DRAWINGS**

A corrected drawing of Figure 8, in compliance 37 CFR 1.121(d), is submitted with this amendment. Applicant respectfully request withdrawal of the objection to the drawings.

### **OBJECTION TO THE CLAIMS**

Applicant respectfully traverses the objections by the Examiner to claims 8-9, but in order to advance prosecution, Claim 8 has been rewritten in independent form. Applicant respectfully requests withdrawal of the objection to claims 8-9.

### **REJECTIONS UNDER 35 U.S.C. 103(A)**

As mentioned above, Applicant respectfully traverses the rejections under 103(a), but has amended the claims in order to advance prosecution. Specifically, Applicant notes that the only reference that possibly discloses a fixed value test-use control signal is Sugano.

Sugano discloses, as shown in Fig. 1, that the manual gain setting circuit 10, which is capable of setting a plurality of test-use control voltages receives a voltage  $V_O$  from the voltage terminal 35. In the manual gain setting circuit 10, as shown in Fig. 4, a single test-use control voltages is generated from the voltage  $V_O$  using resistors 36 to 38 that are connected in parallel. At any given time, a single test-use control voltage is selected and supplied by the rotary switch 30 to the automatic/manual changeover switch shown in Fig. 1. In this regard, the present invention can be distinguished from Sugano, which discloses multiple fixed-value test control voltages to test multiple properties. As described in the specification at page 12, tested properties include:

- Gain property, such as maximum gain, minimum gain, a maximum variable range of gain, and the like,
- Level differences of I/Q base band signal (BBS),

- Phase differences (quadrature property) of I/Q base band signal (BBS), and
- Phase noise property.

An additional characteristic of Sugano is that the circuit for generating control voltages is found inside the manual gain setting circuit 10 in the gain control circuit 1. See Figs. 1 and 4 of Sugano. This configuration results in the integrated circuit becoming larger than it would otherwise be.

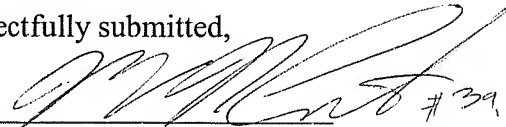
In contrast, the present invention discloses varying test-use control voltages from *outside* the integrated circuit. Accordingly, there is no possibility of the integrated circuit becoming larger by adding a testing circuit inside the integrated circuit. This feature allows reduction of production costs, and is additionally beneficial when a chip size is limited and space is at a premium.


To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As described above, the present invention claims features and discloses effect that are neither disclosed nor suggested in Cai, Sugano, Roberts, or Motojima. Accordingly, withdrawal of the rejections under 35 U.S.C. 103(a) is requested for failure to make out a prima facie case of obviousness. A notice of allowance respectfully solicited. If the Examiner has any questions concerning this application, the Examiner is requested to contact James M. Alpert (Reg. No. 59,926) at the telephone number of (703) 205-8000.

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Respectfully submitted,

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